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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,362	10/15/2001	B.A. Schneiderman	07512.110	1727

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EXAMINER

LUU, SY D

ART UNIT PAPER NUMBER

2174

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,362

Applicant(s)

SCHNEIDERMAN, B.A.

Examiner

Sy D Luu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/3/02 and prior.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/3/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. By merely describing a process, the claims fail to meet the standard format of claiming convention which should include matters such as a method with steps, an apparatus or an article of manufacture. The examiner will interpret claims 31-33 in light of the specification. However, appropriate corrections are required.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically a software application. It appears that the computer system programmed to perform the steps as recited in claim 1 fails to be tangibly embodied on a computer readable medium so as to be executable. Computer programs or software claimed as computer code per se, i.e., the descriptions or expressions of the programs, are not physical

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"things," nor are they statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer program's functionality to be realized. In contrast, a claimed computer - readable medium encoded with a computer program or software defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory. See MPEP §2106 Section IV.B.1(a).

Claim Objections

3. Claim 2 is objected to because of the following informalities: on line 2, the phrase "said wherein said " should be corrected.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-6, 10-11, 13-15, 19-20, 22-24, 28, 30-31, 33-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al. ("Barber", US 5,751,286).

As per claim 1, Barber teaches a computer software-mediated method for annotating an image aspect of an electronic image, wherein said software: causes said electronic image

containing said image aspect to be displayed to a user in a computer-generated interface, causes said interface to permit the user to access and query a searchable electronic database of annotations for an annotation term, and optionally permitting said user to add a desired annotation term to said database (abstract; col. 3, lines 24 et seq.; col. 6, lines 61 et seq.; col. 9, lines 5-61; *each image in the database has a corresponding data representation of its particular characteristics, which would necessarily have been annotated by a user prior to being added to the database*); and causes an annotation of said database to become associated with said image aspect, such that the annotation, in response to a request by a user, is displayed positioned so as to permit a user to identify the associated image aspect in said displayed image (col. 3, lines 32-39).

Barber does not expressly teach the associated annotation to be stored in a second searchable electronic database so as to permit a user to retrieve said electronic image by querying said second electronic database for said annotation. However, the use of a second database in which associated annotations could be stored in would have been an obvious detail implementation depending on design preference. For example, in a network environment, annotations and the images could be all stored on a server, or the annotations could be stored on the client while the images could be stored on the server. These variations on the implementation could be applied depending on preference without affecting the functionality of database querying.

As per claim 2, Barber teaches said computer to be a personal computer, and wherein said displayed image is displayed on the screen of a computer (fig. 5).

As per claim 4, Barber teaches said electronic image to contain more than one image aspect (col. 3, lines 32-34).

As per claim 5, Barber teaches said annotation to be a textual annotation (col. 3, lines 32-34).

As per claim 6, Barber teaches said image to be selected from the group consisting of a photograph, a writing, and a drawing (fig. 5).

Claims 10-11 and 13-15 are similar in scope to claims 1-2 and 4-6 respectively, and are therefore rejected under similar rationale.

Claims 19-20 and 22-24 are similar in scope to claims 1-2 and 4-6 respectively, and are therefore rejected under similar rationale.

Claims 28 and 30 are similar in scope to claims 1 and 5 respectively, and are therefore rejected under similar rationale.

Claims 31 and 33 are similar in scope to claims 1 and 5 respectively, and are therefore rejected under similar rationale.

Claims 34 and 36 are similar in scope to claims 1 and 5 respectively, and are therefore rejected under similar rationale.

6. Claims 3, 12, 21, 29, 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al. ("Barber", US 5,751,286) in view of Whayne et al. ("Whayne", US 6,014,581).

As per claims 3, 12, 21, 29, 32 and 35, Barber does not teach said user to associate said annotation with said image aspect by permitting said user to select, drag and drop said annotation to a user-selected location in the displayed electronic image. Whayne teaches an interface for

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annotating images wherein annotations are associated with image aspects by drag/drop operations, and are stored for subsequent retrievals and manipulations (col. 24, lines 15-67). It would have been obvious to an artisan at the time of the invention to combine Whayne's teaching with Barber in order to facilitate user's process of annotation.

7. Claims 7-9, 16-18, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al. ("Barber", US 5,751,286) in view of Kuchinsky et al. ("Kuchinsky", FotoFile).

As per claims 7-9, Barber does not expressly teach said electronic image to be a photograph, and image aspect to be annotated to be a person depicted in said photograph, as well as said annotation to be a name of said person depicted in said photograph. Kuchinsky teaches all of these features as noted in col. 1 of page 498, and by figure 3 on page 500. It would have been obvious to an artisan at the time of the invention to include Kuchinsky's photographs of a person as images in Barber's method in order to further provide more flexibility in handling different type of images.

Claims 16-18 are similar in scope to claims 7-9 respectively, and are therefore rejected under similar rationale.

Claims 25-27 are similar in scope to claims 7-9 respectively, and are therefore rejected under similar rationale.

Inquires

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sy Luu whose telephone number is **(703) 305-0409**. The examiner can normally be reached on Monday - Thursday from 7:00 am to 4:30 pm (EST). The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'Sy Luu', with a long horizontal stroke extending to the right.

SY D. LUU
PRIMARY EXAMINER